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James W. Hiney, Esq.
P. O. Box 818
Middleburg, VA 23060

EXAMINER

JOHNSON, STEPHEN

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JERRY D. HAM

Appeal 2009-010744
Application 10/738,417
Technology Center 3600

Before WILLIAM F. PATE, III, MICHAEL W. O'NEILL, and
KEN B. BARRETT, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Jerry D. Ham (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 10-19. Claims 1-9 were withdrawn from consideration. Claim 20 was canceled. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

The claimed invention is to a neutralizing system which introduces a gas into a confined area.

Claim 10, reproduced below, is representative of the subject matter on appeal.

10. A CO₂ neutralizing system for use against terrorists and/or hostage takers within a confined space, said system comprising:
a source of CO₂,
manual non-explosive means to create an opening in said space,
and means to deliver said CO₂ from said source into said space,
said means to deliver said CO₂ operatively connected to said means to create an opening.

The Prior Art

The Examiner relies upon the following as evidence of unpatentability:

Roberts	US 2,813,753	Nov. 19, 1957
Medlock	US 2,857,005	Oct. 21, 1958
McClenahan	US 5,062,486	Nov. 5, 1991
Coughlin	US 5,651,417	Jul. 29, 1997

The Rejections

The following Examiner's rejections are before us for review:

Claims 10-15 and 17-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Roberts in view of Medlock or Coughlin.

Claims 10-19 are rejected under 35 U.S.C. § 102(b) as being anticipated by McClenahan.

Claims 10-15 and 17-19 are rejected under 35 U.S.C. § 102(b) as being anticipated by Coughlin.

SUMMARY OF DECISION

We AFFIRM-IN-PART.

DISCUSSION

We have carefully reviewed the rejections on appeal in light of the arguments of the Appellant and the Examiner. We reach the conclusion that claims 10-15 and 17-19 are obvious over Roberts in view of Medlock or Coughlin. We further find that claims 10-15 and 17-19 lack novelty over McClenahan or Coughlin, while claim 16 is novel over McClenahan. Therefore, the rejection of claims 10-15 and 17-19 under § 103 is affirmed and the rejections of claims 10-15 and 17-19 under § 102 are also affirmed (but not addressed), while the rejection for claim 16 is reversed. Our reasons follow.

A determination of anticipation or obviousness begins with claim construction, followed by a comparison of the construed claim to the prior art. *Key Pharm. v. Hercon Labs. Corp.*, 161 F.3d 709, 714 (Fed. Cir. 1998). Pending claims are given their broadest reasonable construction consistent

with the specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Preamble language that merely states the purpose or intended use of an invention is generally not treated as limiting the scope of the claim. *See Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003); *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002); *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997). However, the preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06, (Fed. Cir. 2005); *SanDisk Corp. v. Memorex Prods., Inc.*, 415 F.3d 1278, 1284 n.2, (Fed. Cir. 2005) (citation omitted).

In light of the principles above, we conclude that the preamble language “against terrorists and/or hostage takers” in the claims on appeal does not constitute a limitation of the claims. Our reasoning follows.

First, there is no suggestion in the prosecution history that the inventor added the phrase “against terrorists and/or hostage takers” in order to distinguish the invention from the prior art. Second, the phrase does not provide a necessary antecedent basis for any term in the bodies of any of the claims. Third, and most importantly, the phrase does not embody an essential component of the invention. The phrase is simply a descriptive name for the invention that is fully set forth in the bodies of the claims. The body of the independent claim describes a structurally complete device of a CO₂ source, a means to create an opening in the space (the space being a confined space as recited within the preamble), means to deliver the CO₂ from the source to the space, and a connection between the means to deliver

and means to create the opening, with the dependent claims further defining particular structure to perform the means. Finally, a review of the Specification reveals that the phrase “against terrorists and/or hostage takers” is a label to describe an application for the invention. For example, the detailed description of the invention fails to describe an amount or duration of dispensing of CO₂ that is needed to be used “against terrorists and/or hostage takers.”

For the § 103(a) rejection with Roberts and either Coughlin or Medlock, Appellant argues claims 10-15, and 17-19 as a group. App. Br. 4-7. We select claim 10 as representative, and claims 11-15 and 17-19 stand or fall with claim 10. *See* 37 C.F.R. § 41.37(c)(1)(vii).

The crux of Appellant’s argument against the rejection of claim 10 is that none of the references would be used against terrorists. As noted above, that phrase is in the preamble and does not limit the scope of the claim to only be used against terrorists. The claimed invention is limited to use in a confined space based on the wording within the preamble and the claim body. Appellant does not challenge that Roberts, Coughlin, or Medlock could be used in a confined space. Indeed, a review of Roberts, Coughlin, and Medlock yields finding that the systems disclosed therein are readily capable being used in confined spaces, in particular, Roberts (*see* col. 1, ll. 32-36 (explaining the difficulties encountered with enclosed fires)). As the Examiner noted, the difference between Roberts and the claimed invention is the fluid dispersed through the system. As such, the Examiner cited to Medlock and Coughlin for the teaching that CO₂ can be dispersed through such a structural system disclosed in Roberts and claimed by Appellant. In our view, this appears to be a simple substitution of one element (water mist

or fog) for another already known element (CO₂) within the prior art that does no more than yield a predictable result, namely, fill the confined space with a fluid. Based on Supreme Court precedent, *see KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007), we conclude such a substitution would have been obvious to a person of ordinary skill in the art at the time of the claimed invention.

In view of the foregoing, the Examiner's rejection of claim 10 is sustained. Claims 11-15 and 17-19 fall with claim 10 since Appellant failed to separately argue these claims for this ground of rejection. As such, the Examiner's decision to reject claims 10-15 and 17-19 is affirmed.

Our affirmation of the rejection of claims 10-15 and 17-19 on one ground specified by the Examiner, namely, under § 103(a), constitutes a general affirmation of the decision of the Examiner on those claims. 37 C.F.R. § 41.50(a). We do not address the rejection of claims 10-15 and 17-19 under § 102(b) separately from the rejection of those claims under § 103(a).

We can not sustain the Examiner's rejection of claim 16 as being anticipated by McClenahan. We do not find McClenahan discloses mixing an odorant with the carbon dioxide as called for in claim 16. Accordingly, the Examiner's decision to reject claim 16 is reversed.

DECISION

The Examiner's decision to reject claims 10-15 and 17-19 is affirmed.

The Examiner's decision to reject claim 16 is reversed.

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Application 10/738,417

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

Klh

JAMES W. HINEY, ESQ.
P. O. BOX 818
MIDDLEBURG, VA 23060